

Appl. No. 10/016,853
Amdt. Dated June 9, 2005
Reply to Office action of February 3, 2005
Attorney Docket No. P14738-US1
EUS/JP/05-1158

REMARKS/ARGUMENTS

1.) Impropriety of Finality of Office Action

In the prior Office Action dated February 3, 2005, the Examiner first stated his rejection of the claims in view of Tomoike, a Japanese reference. In response to that Office Action, the Applicants stated that the Examiner had not provided a translation of Tomoike. In the instant Final Office Action, the Examiner repeated his prior rejection in view of Tomoike and, again, did not provide the Applicants a copy of the English-language translation of that reference, nor did he indicate how or where Applicants might obtain a copy. FURTHERMORE, the Examiner failed to provide a proper reference to Tomoike by which Applicants could independently obtain a copy of an English-language translation.

As noted in MPEP 2660, under 37 C.F.R. §1.104(d)(2), "[i]f printed publications are cited [by the Examiner], the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given." The Examiner failed to meet this requirement. First, the Japanese language copy of the Tomoike reference provided by the Examiner has an apparent patent number on its face of 10-13945 (copy attached – Exhibit A). The Applicants' search for an English-language copy of the abstract of that patent, however, only returned a Japanese publication, having a publication number 01013945A, related to preserving pickles (copy attached – Exhibit B). Thus, from the face of the Japanese language Tomoike reference provided by the Examiner, it was not possible for Applicants to obtain an English-language copy of the Abstract. Second, both in the Office Action comments and the Notice of References Cited, the Examiner refers to Tomoike by the document number "JP410013945A," which is also incorrect. Applicants have only now discovered that the "4" following "JP" in that document number is incorrect, and that only by searching using the publication number "10013945A" is it possible to obtain the English-language abstract of Tomoike (copy attached – Exhibit C). Thus, the Examiner did not provide the Applicants with the correct information through which an English-language copy of the abstract of Tomoike could be found, in either the prior office action or the present one, and, therefore, the Examiner failed to comply with 37 C.F.R. §1.104(d)(2).

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Finally, the Examiner's attention is directed to MPEP §706.02, wherein it is provided:

II. RELIANCE UPON ABSTRACTS AND FOREIGN LANGUAGE DOCUMENTS IN SUPPORT OF A REJECTION

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. **Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art.** See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. **The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection.** An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. When **both** [emphasis in original] the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a **non-final** Office action based in whole or in part on the abstract only without relying on the full text document. **In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action.** (emphasis added).

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Therefore, if the Examiner wishes to maintain a rejection based on Tomoike, a full text English translation of Tomoike should be provided prior to a final rejection.

For these reasons, the Applicants request that the finality of the present Office Action be withdrawn.

2.) Claim Rejections – 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-2, 5-6, 9-10 and 13-14 as being unpatentable over Granberg (US 6,101,382) in view of Tomoike (JP 410013945A), and claims 3-4, 7-8, 11-12 and 15-16 as being unpatentable over Granberg in view of Tomoike and further in view of Grootwassink (US 6725037). The Applicants traverse the rejections.

With respect to claims 1, 5, 9 and 13, the Examiner recognizes that Granberg fails to disclose certain limitations common to each of those claims. Recognizing the deficiencies of Granberg, the Examiner, referring merely to the Abstract of Tomoike, states that all of the limitations not disclosed in Granberg are disclosed in Tomoike. The Examiner asserts that Tomoike "clearly discloses the limitation 'assigning an authentication code to said roaming number, said response including said authentication code, receiving said authentication code at HLR and sending said authentication code from HLR to said GMSC' (see abstract)." The Examiner's assertions as to what is taught by Tomoike are not supportable by a reading of the Tomoike abstract. In particular, Tomoike fails to disclose "assigning an authentication code to [a] roaming number." What Tomoike describes in the abstract is 1) authenticating a roaming terminal and, then, 2) sending a roaming number to the terminal. This is particularly clear from the statement in the Tomoike abstract that, "[w]hen authentication [of the terminal 10] is completed, the network 20 acquires a roaming number and notifies it to the terminal 10 and the network 30." Because Tomoike discloses acquiring a roaming number only after the mobile terminal is authenticated, it is without question that Tomoike fails to teach assigning an authentication code to a roaming number, as recited in Applicants' claim 1.

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In contrast to the apparent teachings of Tomoike, the authentication code utilized in Applicants' invention is not used to authenticate a mobile terminal, but is used to prevent the unauthorized use of roaming numbers. The invention embodies a process by which it can be assured that a call to a roaming number associated with an MSC is not simply a direct call to the roaming number, but is in fact a call to a B subscriber Mobile Station to which the MSC can assign the roaming number.

Claim 1 recites:

1. A method for preventing unauthorized use of roaming numbers in a wireless telecommunications system, said method comprising the steps of:
 - receiving a call request for a mobile terminal at a Gateway Mobile Switching Center (GMSC);
 - sending a request for routing information from said GMSC to a Home Location Register (HLR) associated with said mobile terminal;
 - sending a request for a roaming number from said HLR to the Mobile Switching Center (MSC) associated with the roaming area in which said mobile terminal is geographically located;
 - allocating, by said MSC, a roaming number for said mobile terminal;
 - assigning, by said MSC, an authentication code to said roaming number;
 - sending a response to said request for roaming number from said MSC to said HLR, said response including said roaming number and said authentication code;
 - receiving said roaming number and said authentication code at said HLR;
 - sending said roaming number and said authentication code from said HLR to said GMSC;
 - sending a call setup request from said GMSC to said MSC, said call setup request including said roaming number and said authentication code;
 - confirming, by said MSC, said authentication code in said call setup request; and,
 - if said authentication code for said roaming number is confirmed by said MSC, completing said call request to said mobile terminal. (emphasis added)

Granberg and Tomoike fail to disclose, either individually or in combination, each and every limitation of claim 1. In particular, the Examiner has pointed to no teaching

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wherein: 1) an MSC assigns an authentication code to a roaming number, 2) an MSC sends a response to a request for a roaming number to an HLR, wherein the response includes a roaming number and an authentication code for that roaming number, 3) an HLR sends a roaming number and an authentication code for that roaming number to a GMSC, 4) a call setup request is sent from a GMSC to an MSC, wherein the call setup request includes a roaming number assigned by that MSC and the authentication code for that roaming number, or 5) confirming by the MSC the authentication code in the call setup request and, if the authentication code for the roaming number is confirmed by the MSC, completing the call request to the mobile terminal. Accordingly, the Examiner has not established a *prima facie* case of obvious of claim 1 in view of Granberg and Tomoike.

Whereas claims 5, 9 and 13 include limitations analogous to those of claim 1, those claims are also not obvious in view of Granberg and Tomoike. Furthermore, whereas claims 2-4, 6-8, 10-12 and 14-16 are dependent from claims 1, 5, 9 and 13, respectively, and include the limitations thereof, those claims are also not obvious.

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CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-16.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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Date: June 9, 2005

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